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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,388	03/19/2004	John Covert	034734.00002	7229

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EXAMINER

DONAGHUE, LARRY D

ART UNIT	PAPER NUMBER
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2154

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03/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,388	Applicant(s) COVERT ET AL.	
	Examiner Larry D. Donaghue	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/19/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Claims 1-20 are presented for examination.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a program per se.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims are rejected under 35 U.S.C. 102(e) as being anticipated by Tuvey et al. (2002/0019849).

Tuvey et al. taught the invention as claimed (claim 1) system for integrating with an existing electronic message client for creating customized electronic messages comprising: a computer readable medium; at least one message wrapper in communication with said computer readable medium (para 23); and a set of computer readable instructions embodied in said computer readable medium for receiving an electronic message from the user (para. 21), retrieving said at least one message wrapper and integrating said at least one wrapper with said electronic message for creating a branded electronic message (para. 22-23) prior to instigating transmission of said electronic message to the recipient so that a branded electronic message is created for transmission to the recipient (para. 24).

As to claim 2, Tuvey et al. taught set of message wrappers in communication with said computer readable medium having a plurality of message wrappers; user information in communication with said computer readable medium having wrapper preference information representing the preferred wrapper of the user from said set of message wrappers; and, said set of computer readable instructions include instructions for retrieving at least one wrapper from said set of message wrappers according to said user information. (para. 41-47).

As to claim 3, Tuvey et al. taught instructions for receiving wrapper selection information from the user and retrieving a second message wrapper from said set of message wrappers according to said wrapper selection information so that said second message wrapper can be used to create said branded electronic message (para. 41-47, para. 70).

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As to claim 4, Tuvey et al. taught Instructions include instructions for updating said set of wrappers and said user information whereby said set of wrappers and said user information can be centrally modified (para. 070, para. 41- para.47).

Claims 9-10 and 13-16 and 20 are rejected for similar rationale as claims 1-4.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-8, 11-12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuvey et al. as applied to claims 1-4, 9-10 , 13-16 and 29 above, and further in view of Neilson (5,870,548).

As to claims 6-8, Tuvey et al. did not expressly teach the modifying ,canceling or reviewing of a message. Nielson taught this and the desirability of having that ability. (6A-6D, col. 1line 40- col. 2, line 10). Claims 11-12 and 17-19 are rejected for similar rationale as claims 6-8.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brown et al.	2002/0078158
Leonard et al.	6,721,784
Ostermann et al.	7,035,803
Landress et al.	2003/0191816
Silverstein et al.	2004/0093281

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry D Donaghue/

Primary Examiner, Art Unit 2154